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In re PATENT APPLICATION of
Inventor(s) Avner SHAFRIR et al.
Appin. No. 09/583,734

Filed: 5/31/00 Atty. Dkt. 042846-0312790

TITLE: Collaborative Application Date: FEBRUARY 1, 2006
with Indicator of Concurrent
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APPEAL BRIEF UNDER 37 C.F.R. §41.37

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APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. §41.37
U.S. Application Serial No. 09/583,734
Attorney Docket No. 042846-0312790

FEB 01 2006**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICANT: Avner SHAFRIR, *et al.*
SERIAL NUMBER: 09/583,734 EXAMINER: Tadesse Hailu
FILING DATE: May 31, 2000 ART UNIT: 2173
FOR: COLLABORATIVE APPLICATION WITH INDICATOR OF CONCURRENT USERS

APPEAL BRIEF UNDER 37 C.F.R. § 41.37**Mail Stop Appeal Brief - Patents**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Dear Sir:

Further to the Notice of Appeal filed on December 1, 2005 and the Notice of Panel Decision from Pre-Appeal Brief Review mailed December 23, 2005, Appellants respectfully submit an Appeal Brief pursuant to 37 C.F.R. §41.37.

The Director is authorized to charge the \$500.00 fee for filing an Appeal Brief pursuant to 37 C.F.R. §41.20(b)(2). The Director is further authorized to charge any additional fees that may be due, or credit any overpayment of same to Deposit Account No. 033975 (Ref. No. 042846-0312790).

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I. 37 C.F.R. § 41.37(c)(1)(i) – REAL PARTY IN INTEREST

The real party in interest is International Business Machines Corporation.

II. 37 C.F.R. § 41.37(c)(1)(ii) – RELATED APPEALS AND INTERFERENCES

U.S. Patent Application Serial No. 09/583,736 (hereinafter "the '736 Application"), entitled "COMMUNICATIONS LINK SYSTEM BASED ON USER INDICATOR," and filed May 31, 2000, is currently on Appeal before the Board of Patent Appeals and Interferences. An Appeal Brief in the '736 Application is filed concurrently with the instant Appeal Brief.

U.S. Patent Application Serial No. 09/580,904 (hereinafter "the '904 Application"), entitled "VISUAL INDICATOR OF NETWORK USER STATUS BASED ON USER INDICATOR," and filed May 31, 2000, is currently on Appeal before the Board of Patent Appeals and Interferences. An Appeal Brief in the '904 Application is due February 28, 2006¹.

¹ It is noted that there is no explicit cross-reference to the '736 Application or the '904 Application appears in the instant Application. Applicants intend to amend the specification of the instant Application to include these cross-references upon entry of a favorable Decision by the Board of Patent Appeals and Interferences.

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III. 37 C.F.R. § 41.37(c)(1)(iii) – STATUS OF CLAIMS

Pending: Claims 1-23 are pending.

Cancelled: No claims are cancelled.

Rejected: Claims 1-23 stand rejected.

Allowed: No claims have been allowed.

On Appeal: The rejection of claims 1-23 under
35 U.S.C. § 103(a) is appealed.

IV. 37 C.F.R. § 41.37(c)(1)(iv) – STATUS OF AMENDMENTS

No Amendments have been filed subsequent to Final Rejection.

V. 37 C.F.R. § 41.37(c)(1)(v) – SUMMARY OF CLAIMED SUBJECT MATTER

Various instant messaging type applications now exist. One feature of some of these applications is that they can provide an indication of the status of network users (e.g., whether they are detected to be online). However, this user status feature is typically specific to that instant messaging application and enables communication with a user via the instant messaging application.

Another aspect of the invention, a user indicator, can be presented within two or more *types* of electronic documents using two or more *types* of applications. (Specification at page 7, lines 11-19).

One advantage of this aspect of the invention is that it extends the user indicator feature across multiple applications and multiple document types. According to one embodiment, the system may include a user indicator presentation means for enabling presentation of at least one user indicator within *two or more types of electronic documents*. The electronic document types are recited as being capable of being generated using the *two or more types of*

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applications. (Specification at page 6, lines 1-10). The user indicator(s) is (are) associated with the one or more target network users. A status presenting means for presenting status indicators associated with corresponding user indicators provide *the real-time status* of the one or more target network users. (Specification at page 10, lines 2-4). A communication means is provided for enabling the first network user to initiate communications with at least one of the target network users by selecting the desired user indicator. (Specification at page 10, lines 10-27).

For example, the invention may include *two or more user indicators* presented in two or more types of documents generated by two or more types of applications, including at least *two user depictions* associated with at least two target network users. (Specification at page 17, lines 1-20). An identification determining module may reference a user directory to access at least two user indicators that correspond to the at least two target network users. (Specification at page 10, lines 28-32). The presentation module is capable of presenting the at least two user indicators within the two or more types of electronic documents that are capable of being generated using the two or more types of applications. A status determining module may determine real-time status of the at least two target network users including an availability of the at least two target network users to engage in a communication. (Specification at page 10, lines 2-4). A communication module can establish a communication link with one or more of the at least two target network users based on the determined availability of the at least two target network users. (Specification at page 14, lines 24-32). One advantage of this aspect of the invention is that it enables display to a first user of a list of target network users and their status.

VI. 37 C.F.R. § 41.37(c)(1)(vi) – GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL (35 U.S.C. § 103).

Claims 1-23 stand rejected under 35 U.S.C. 103(a) as allegedly being obvious over Mirabilis LTD, Quick Tour ("Quick Tour"), allegedly disclosed February 12, 1998, in

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view of ICQ Inc., ICQ Email Signature ("Email Signature"), allegedly disclosed May 2, 1999.

VII. 37 C.F.R. § 41.37(c)(1)(vii) – ARGUMENT

A. The Rejection of Claims 1-23 fails to establish a prima facie case of obviousness

The rejection of Claims 1-23 under 35 U.S.C. §103(a) as allegedly being obvious over Mirabilis LTD, Quick Tour ("Quick Tour"), allegedly disclosed February 12, 1998, in view of ICQ Inc., ICQ Email Signature ("Email Signature")², allegedly disclosed May 2, 1999 is legally improper for at least the following reasons.

Independent claim 1 recites, among other things, "user indicator presentation means enabling presentation of at least one user indicator within *two or more types of electronic documents*, wherein the electronic document types are capable of being *generated using the two or more types of applications*" and wherein each user indicator is associated with a target network user. Neither Quick Tour nor Email Signature, whether considered alone or in combination, disclose at least these features.

The Examiner acknowledges that Quick Tour fails to disclose these features. Final Office Action, p. 5. The Examiner erroneously relies on Email Signature to overcome this admitted deficiency. However, the Examiner has failed to establish that Email Signature discloses these features admittedly missing from the primary reference.

One of the legal errors committed by the Examiner is the failure to properly consider the specific claim language referred to above. The Examiner relies on Email

² Applicant believes that it can antedate one or more of the references and reserves the rights to do so should this be necessary. However, given the failure of the Examiner to establish a prima facie case of obviousness, Applicant believes that this is unnecessary at this time and prefers to avoid the unnecessary costs associated therewith.

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Signature for allegedly enabling a user to include a signature block including a user's ICQ address in an email message, and allegedly providing a link to initiate a communication³.

Assuming, *arguendo*, that it would have been obvious to incorporate such a feature into the teachings of the system in the Quick Tour reference, the combination would still fail to teach or suggest certain claim elements. The Examiner does not even allege that the signature block in Email Signature provides an indication of the user's status. Thus, this aspect of the claim is not satisfied. Moreover, the Examiner fails to establish that combination discloses enabling the presentation of at least one user indication within *two or more types* of electronic documents, wherein the electronic documents are capable of being generating using *two or more types of applications*, as recited in independent claim 1.

Email Signature appears to describe an email signature that is viewable by two or more email applications. Two different email applications are not different *types of applications*. Rather, they are two instances of the same type of application. Nor are two emails two different *types of documents*. Rather, they are two of the *same type* of documents. An email application, which is one type of application, typically generates one type of electronic document – an email. Thus, the combination fails to satisfy at least these recitations of claim 1.

The Examiner alleges, without support, that taking the electronic mail signature described in Email Signature and incorporating it into "chat documents," "HTML documents," "Telephonic documents," and "audio-video document" meets the claim language (*see* Final Office Action, pages 5 and 6). The Examiner points to nothing in the references that appear to teach or suggest this.

Independent claims 6, 10, 15, 22, and 23 each recite patentable features similar to those described above in reference to claim 1. As such, these claims are allowable for at

³ It appears that the communication is a chat communication. To the extent this may have inadvertently been characterized otherwise earlier in the prosecution, those statements are hereby corrected.

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least the reasons provided above. Claims 2-5, 7-9, 11-14, and 16-21 depend from, and add features to, the independent claims. Thus, these claims are allowable at least by virtue of their dependency from allowable claims.

B. Claims 2, 7, 11 and 16 are Separately Patentable

Claims 2, 7, 11, and 16 further recite "preference presentation means for presenting the network users preference for receiving communications" (or similar recitations). The Examiner ignores the specific language of these claims and fails to provide any evidence that these features are disclosed in the references.

C. Claim 17 is Separately Patentable

Claim 17 further recites that the user can prioritize preferences for how a user receives a communication. The Examiner ignores the specific language of these claims and fails to provide any evidence that these features are disclosed in the references.

D. Claims 4, 5, 13, 14 and 19 are Separately Patentable

Claims 4, 5, 13, 14, and 19 further recite "conference communication means for enabling the network users to establish conference communications with the one or more target network users" (or similar recitations). The Examiner ignores the specific language of these claims and fails to provide any evidence that these features are disclosed in the references.

E. Claims 21-23 are Separately Patentable

Claims 21-23 each refer to communications based on a determined availability. The Examiner ignores the specific language of these claims and fails to provide any evidence that these features are disclosed in the references.

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Claim 22 further specifies using "non-HTML" applications. The Examiner fails to provide any evidence that this feature is found in either of the references. Both of the references relate to HTML based documents. Email Signature specifically references an HTML signature.

Claim 23 further recites "at least two user indicators within the documents, wherein the user indicator presentation module is capable of presenting the at least two user indicators within the two or more types of electronic documents that are capable of being generated using the two or more types of applications." The Examiner provides no evidence that these features are present in either of the references. One advantage of this is that it enables a list of user indicators to be included in different document types, and enables the multiple user's status to be indicated in those documents. The Email Signature reference clearly relates simply to the ICQ # of a single user.

F. No Suggestion to Combine

The Examiner also fails to provide a legally sufficient basis for modifying Quick Tour in light of Email Signature. The alleged basis is merely conclusory and constitutes impermissible hindsight. There is no factual showing as required by applicable case law.

VIII. 37 C.F.R. § 41.37(c)(1)(viii) – CLAIMS APPENDIX

Appendix A: The pending claims (claims 1-23) are attached in Appendix A.

IX. 37 C.F.R. § 41.37(c)(1)(ix) – EVIDENCE APPENDIX

Appendix B: None

X. 37 C.F.R. § 41.37(c)(1)(x) – RELATED PROCEEDINGS INDEX

Appendix C: None

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CONCLUSION

For at least the foregoing reasons, the Examiner has failed to establish a prima facie case of obviousness. The rejection of each of claims 1-23 must be overturned.

Date: February 1, 2006

Respectfully submitted,

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APPENDIX A

CLAIMS

1. (Previously presented) A system for enabling network users to determine a real-time status of one or more target network users and to establish communications with the one or more target network users using a user indicator that is presented using two or more types of applications, the system comprising:

user indicator presentation means for enabling presentation of at least one user indicator within two or more types of electronic documents, wherein the electronic document types are capable of being generated using the two or more types of applications and wherein each user indicator is associated with the one or more target network users;

status presenting means for presenting status indicators associated with corresponding user indicators to provide the real-time status of the one or more target network users; and

communication means for enabling the network users to initiate communications with the one or more target network users upon selection of the desired user indicator.

2. (Previously presented) The system of claim 1, further comprising preference presentation means for presenting the network users preference for receiving communications.

3. (Previously presented) The system of claim 1, further comprising updating means for updating the real-time status of the one or more target network users.

4. (Previously presented) The system of claim 1, further comprising conference communication means for enabling the network users to establish conference communications with the one or more target network users.

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5. (Previously presented) The system of claim 4, wherein the conference communication means enable the network users to share at least one application.

6. (Previously presented) A method for enabling network users to determine a real-time status of one or more target network users and to establish communications with the one or more target network users using a user indicator, the system comprising the steps of:

generating two or more types of electronic documents using two or more types of applications;

presenting one or more user indicators within the two or more types of electronic documents, each user indicator being associated with at least one network user;

presenting the real-time status of the one or more target network users associated with the one or more user indicators via the two or more types of applications, the real-time status including an availability of the one or more target network users to engage in a communication; and

establishing a communication link with the one or more target network users based on the indicated availability of the one or more target network users.

7. (Previously presented) The method of claim 6, further comprising the step of enabling the one or more target network users to establish one or more communication preferences.

8. (Previously presented) The method of claim 6, further comprising the step of updating the real-time status of the one or more target network users.

9. (Previously presented) The method of claim 6, further comprising the step of enabling the network users to share at least one application.

10. (Previously presented) A system for enabling network users to determine a real-time status of one or more target network users and to establish

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communications with the one or more target network users using a user indicator, the system comprising:

a user indicator presentation module for presenting at least one user indicator within two or more types of electronic documents, wherein the electronic document types are capable of being generated using two or more types of applications and wherein each user indicator is associated with at least one target network user;

a status determining module that determines the real-time status of the one or more target network users including an availability of the one or more target network users to engage in a communication; and

a communication module that establishes a communication link with the one or more target network users based on the determined availability of the one or more target network users presented by the two or more types of applications.

11. (Previously presented) The system of claim 10, further comprising a communication options preference presentation module that presents the network users preference for receiving communications.

12. (Previously presented) The system of claim 10, further comprising a status updating module that updates the real-time status of the one or more target network users.

13. (Previously presented) The system of claim 10, further comprising a conference communication module that enables the network users to establish conference communications with the one or more target network users.

14. (Previously presented) The system of claim 13, wherein the conference communication module enables the network users to share at least one application.

15. (Previously presented) A processor readable medium having processor readable code embodied therein for enabling at least one network user to obtain a real-

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time status of one or more target network users and establish a communication link using the real-time status of one or more target network users comprising:

processor readable code that causes a processor to enable the at least one network user to generate two or more types of electronic documents using two or more types of applications;

processor readable code that causes the processor to present at least one user indicator within the two or more types of electronic documents, each user indicator being associated with the one or more target network users;

processor readable code that causes the processor to provide the real-time status of the one or more target network users including an availability of the one or more target network users to engage in a communication; and

processor readable code that causes the processor to establish a communication link with the one or more target network users, based on the indicated availability of the one or more target network users presented by the two or more types of applications.

16. (Previously presented) The medium of claim 15, further comprising processor readable code that causes the processor to present a preference of the at least one network user to receive communications.

17. (Previously presented) The medium of claim 16, further comprising processor readable code that causes the processor to enable the one or more target network users to prioritize the preferences.

18. (Previously presented) The medium of claim 15, further comprising processor readable program code that causes the processor to update the real-time status of the one or more target network users.

19. (Previously presented) The medium of claim 15, further comprising processor readable code that causes the processor to enable the at least one network

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user to establish conference communications with the one or more target network users.

20. (Previously presented) The medium of claim 15, wherein the processor readable code enables the at least one network user to share at least one application upon establishing conference communications.

21. (Previously presented) A system for enabling network users to determine a real-time status of one or more target network users and to establish communications with the one or more target network users using a user indicator, the system comprising:

a user indicator presentation module associated with a first type of application for presenting at least one user indicator within two or more types of electronic documents, wherein the electronic document types are capable of being generated using two or more types of applications and wherein each user indicator is associated with at least one target network user;

a status determining module associated with a second type of application that determines the real-time status of the one or more target network users including an availability of the one or more target network users to engage in a communication, wherein the first application type and the second application type are different application types; and

a communication module that establishes a communication link with the one or more target network users based on the determined availability of the one or more target network users presented by the two or more types of applications.

22. (Previously presented) A system for enabling network users to determine a real-time status of one or more target network users and to establish communications with the one or more target network users using a user indicator, the system comprising:

a user indicator presentation module for presenting at least one user indicator within two or more types of electronic documents, wherein electronic document types

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are capable of being generated using two or more types of non-HTML applications, each user indicator being associated with at least one target network user;

a status determining module that determines the real-time status of the one or more target network users including an availability of the one or more target network users to engage in a communication; and

a communication module that establishes a communication link with the one or more target network users based on the determined availability of the one or more target network users presented by the two or more types of non-HTML applications.

23. (Previously presented) A system for enabling network users to determine a real-time status of a plurality of target network users and to establish communications with one or more of the plurality of target network users using two or more user indicators presented in two or more types of documents generated by two or more types of applications, the system comprising:

a user directory that includes user information that corresponds to the plurality of target network users, wherein the user information includes user indicators;

documents generated by the two or more types of applications, wherein each document includes at least two user depictions associated with at least two target network users;

an identification determining module that references the user directory to access at least two user indicators that correspond to the at least two target network users associated with the at least two user depictions included in the documents;

a user indicator presentation module that presents the at least two user indicators within the documents, wherein the user indicator presentation module is capable of presenting the at least two user indicators within the two or more types of electronic documents that are capable of being generated using the two or more types of applications;

a status determining module that determines real-time statuses of the at least two target network users including an availability of the at least two target network users to engage in a communication; and

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a communication module that establishes a communication link with one or more of the at least two target network users based on the determined availability of the at least two target network users presented by the two or more types of applications.

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APPENDIX B

EVIDENCE APPENDIX - 37 C.F.R. §41.37(c)(1)(ix)

(None)

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APPENDIX C

RELATED PROCEEDINGS INDEX - 37 C.F.R. §41.37(c)(1)(x)

(None)